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NIXON & VANDERHYE P.C.  
1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714

EXAMINER

ARSHAD, UMAR

ART UNIT PAPER NUMBER

2174

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/809,095

Applicant(s)

OHNISHI, AKINORI

Examiner

Umar Arshad

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Objections***

Claim 2 is objected to because of the following informalities: the use of the phrase "on the other hand" on line 6 is awkward and does not adhere to normal claim language. The examiner suggests replacing the phrase "on the other hand" with "and" or "otherwise". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "in pair" in claim 1 is a relative term which renders the claim indefinite. The term "in pair" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would

not be reasonably apprised of the scope of the invention. The display positions of the file icon and the reduced-size image are rendered indefinite by use of this term.

The term "proximity" in claim 5 is a relative term which renders the claim indefinite. The term "proximity" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The display position of the icon return space is rendered indefinite by use of this term.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Morris et al., U.S. Patent No. 6,097,389.

As per claim 1, Morris et al. teach an operation method for processing data file, comprising the steps of:

- (a) displaying a reduced-size image for use in identifying contents of a data file, and a file icon associated with said reduced-size image in pair at a predetermined interval between them, said file icon having a smaller area than said reduced-size image (see Morris et al., figure 12B, items 809 and 807, column 6, lines 19 – 33, and column 15, lines 33 – 44; the examiner interprets the icons displayed in the thumbnail display as file icons and the scaled image as the reduced-size image); and
- (b) performing at least either one of the operations of i) selecting a function to be applied to said data file and ii) changing a display position of said reduced-size image by a drag-and-drop operation on said file icon (see Morris et al., column 13, lines 37 – 67, and column 14, lines 1 – 11).

As per claim 3, which is dependent on claim 1, Morris et al. teach the method of claim 1 (see rejection above). Morris et al. further teach the method wherein:

in said step (b), when said file icon is dropped at position where any function icon representing a kind of a function to be applied to said data file is not displayed, a display position of the corresponding reduced-size image is changed by moving the corresponding reduced-size image to a position at a predetermined interval from a dropped position of said file icon (see Morris et al, column 6, lines 37 – 67 and column 14, lines 1 – 11; it is inherent that there is no function icon when the thumbnail file icon is moved to a new position by a drag-and-drop operation, and when the icon is moved,

the display position for the reduced-size image is changed to correspond to the changed position of said thumbnail file icon).

As per claim 4, which is dependent on claim 3, Morris et al. teach the method of claim 3 (see rejection above). Morris et al. further teach the method wherein:

said reduced-file image is displayed in an area on the opposite side of a moving region of the file icon where the file icon is moved to a display position of a function icon (see Morris et al., figure 12b, items 804, 807 and 809, column 13, lines 37 – 67 and column 14, lines 1 – 11; the examiner interprets item 804 to be function icons, and item 807 as the moving region where the thumbnail file icon can be moved to).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Johnston, Jr. et al., U.S. Patent No. 5,598,524 and Belfiore et al., U.S. Patent No. 5,611,060.

As per claim 2, which is dependent on claim 1, Morris et al. teach the method of claim 1 (see rejection above). Morris et al. further teach the method wherein:

in said step (b), the reduced-size image is fixed at a current position while a drag operation on said file icon is being performed (see Morris et al., column 13, lines 37 – 67, and column 14, lines 1 – 11).

Morris et al. teach indicating a drag operation by a visual change (see Morris et al., column 13, lines 37 – 62). Morris et al. do not teach indicating a drag operation by displaying a frame in size of the reduced size image. Johnston, Jr. et al. teach displaying a frame in size of a display object as it is dragged (see Johnston, Jr. et al., figures 13a, items 1300 and 1310 and column 13, lines 25 – 33).

Morris et al. teach performing an action when a threshold is breached during a drag operation (see Morris et al., column 13, lines 37 – 62; the display order is changed when the thumbnail is dragged onto a different part of the screen). Morris et al. do not teach performing an action if a drag speed threshold is breached while dragging.

Belfiore et al. teach performing an action if a drag speed threshold is breached while dragging (see Belfiore et al., column 3, lines 45 – 60). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of

Johnston et al. and Belfiore et al. with the method of Morris et al. in order to provide an improved method of providing visual feedback when a threshold is breached.

Claims 5 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirose, U.S. Patent No. 5,745,112.

As per claim 5, which is dependent on claim 1, Morris et al. teach the method of claim 1 (see rejection above). Morris et al. does not teach the method wherein:

in said step (b), when the file icon has moved to a position more than a predetermined distance apart from the corresponding reduced-size image, an icon return space is displayed at or in a proximity of the original display position of the file icon, at a predetermined fixed interval from the reduced-size image.

Hirose teaches when an icon is moved, an icon return space is displayed at or in a proximity of the original display position of the icon (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; the examiner interprets the dotted line 303 as a return space as it is located at the original position of the file icon 303). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Hirose with the method of Morris et al. in order to display the area in which an icon was originally located when the icon has been dragged and moved from its original location.



As per claim 6, which is dependent on claim 5, Morris et al. and Hirose teach the method of claim 5 (see rejection above). Hirose further teaches in said step (b), when said file icon is dropped in said icon return space, said file icon is moved back to its original display position without moving the associated reduced-size image (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; it is inherent that; it is inherent that when the icon is dropped in the return space it will be in its original position and no changes will occur because the return space is the original location of the icon and by placing it back in the original location no state change will occur).

As per claim 7, which is dependent on claim 5, Morris et al. and Hirose teach the method of claim 5 (see rejection above). Hirose further teaches the method wherein said icon return space is formed in an outstanding pattern (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; the examiner interprets a dotted line as an outstanding pattern).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirose, U.S. Patent No. 5,745,112 further in view of Aparicio, IV et al., U.S. Patent No. 5,727,174.

As per claim 8, which is dependent on claim 5, Morris et al. and Hirose teach the method of claim 5 (see rejection above). Morris et al. do not teach displaying an icon

return space. Hirose teaches displaying an icon return space but do not teach wherein said icon return space is larger in size than said icon. Aparicio, IV et al. teach a method wherein an icon return space is larger in size than said file icon (see Aparicio, IV, figure 6, items 47, and 49; the examiner interprets the empty mini-desk icon area as the return space, it is inherent that the assistant icon is smaller in size than the return space). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Aparicio, IV et al. with the method of Morris et al. and Hirose in order to make it clearer to the user where the icon returns to.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Arshad whose telephone number is (703) 305-0329. The examiner can normally be reached on Monday - Friday, 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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*Kristine Kincaid*  
KRISTINE KINCAID  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100